



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,198	01/24/2007	Yoshiaki Kusunoki	0925-0233PUS1	5538
2292 7590 09/16/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER HARVEY, DAVID E				
ART UNIT 2621		PAPER NUMBER		
NOTIFICATION DATE 09/16/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/590,198

**Applicant(s)**

KUSUNOKI ET AL.

**Examiner**

DAVID E. HARVEY

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 11/24/2008, 10/3/2006, and 8/22/2006



**1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.**

**2. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) In claim 1, line 18, the conditional "if" terminology is confusing and indefinite because the terminology seems to suggest that it is inclusive of the "if not" state in which case recitations dependent therefrom appear to become ineffective and drop out of the claim. Clarification is required. It is noted that clarification could be made by changing "if" to --when-- whereby the limitations that depend therefrom must be effective at least some of the time.

Similar clarification is needed for the "if" terminology recited in: line 2 of claim 3; line 5 of claim 7; line 12 of claim 8; line 2 of claim 10; and line 5 of claim 14.

**4. The examiner hereby cites PCT Patent Publication #WO 2004/100538 to Kita et al which was published on 11/18/2004. With respect to this document, the following is noted:**

A) This PCT publication is not an English language document. However, U.S. Patent Document #2005/0286867 is the national stage of said PCT publication and, as such, constitutes a certified translation of said PCT publication.

B) With respect to the "prior art" of Kita et al. [#WO 2004/100538], it is noted that applicant cannot rely upon the foreign priority papers to overcome rejections that follow because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

**5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**6. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by PCT Patent Document #WO 2004/100538 to Kita et al (wherein U.S. Patent Document #2005/0286867 to Kita et al., cited by applicant, is relied on as being a “certified translation” thereof) [SEE: paragraph 4 of this Office action].**

Kita et al. discloses a CPU controlled receiver (i.e., @ Figure 1) which comprised:

A) A “recording means” [e.g., @ 3] for recording broadcast programs onto a predetermined recording medium [e.g., the hard disk(s) therein] wherein the broadcast programs are extracted [e.g., @ 1 and/or 31] from received input signals;

B) A “recording programming means” [e.g., @ 2] for setting the recording start and end times of a given “first” broadcast program [e.g. “drama A”] [Note paragraphs 0042, 0054 and 0069 of the translation document];

C) A “program acquisition means” for acquiring EPG information [e.g., @ 1 and/or 31] [Note paragraphs 0040-0042 of the translation document];

D) An “extension keyword search means” [e.g., @ 2] for searching the EPG data pertaining to second broadcast programs [e.g., “baseball”], i.e., that are broadcast on the same channel prior to said first broadcast program, for character data representing predetermined extension keywords [Note paragraphs 0057 and 0069 of the translation document];

and

E) “Delay means” [e.g., @ 2] for delaying the start and/or end recording times of the “first” broadcast program [e.g. “drama A”] according to detected extension keywords [Note paragraph 0069 of the translation document].

**7. Claims 2-7 are rejected under 35 U.S.C. 102(a) as being anticipated by PCT Patent Document #WO 2004/100538 to Kita et al for the same reasons that were set forth above for claim 1. Additionally:**

**A) With respect to claim 2:**

See paragraphs 0057-0063 and 0069 of the translation document.

**B) With respect to claim 3:**

The examiner notes that "adding" a time period a multiple of times is the same as multiplying.

**C) With respect to claim 4:**

See abstract of applied PCT document and paragraphs 0057 of the translation document.

**D) With respect to claim 5:**

See paragraph 0053-0055 and 0057 of the translation document. It is the examiner's position that the claim, as recited, falls short of requiring the detection of the "spacing".

**E) With respect to claims 6 and 7:**

Kita et al. describes a configuration in which extension data is looked for only with respect to programs of a specific genre [note paragraphs 0056 and 0069 of the translation document].

**8. Claim 8 is rejected under 35 U.S.C. 102(a) as being anticipated by PCT Patent Document #WO 2004/100538 to Kita et al for the same reasons that were set forth above for claim 1.**

**9. Claims 9-14 are rejected under 35 U.S.C. 102(a) as being anticipated by PCT Patent Document #WO 2004/100538 to Kita et al for the same reasons that were set forth above for claim 8. Additionally:**

**A) With respect to claim 9:**

See paragraphs 0057-0063 and 0069 of the translation document.

**B) With respect to claim 10:**

The examiner notes that "adding" a time period a multiple of times is the same as multiplying.

**C) With respect to claim 11:**

Art Unit: 2621

See abstract of applied PCT document and paragraphs 0057 of the translation document.

D) With respect to claim 12:

See paragraph 0053-0055 and 0057 of the translation document. It is the examiner's position that the claim, as recited, falls short of requiring the detection of the "spacing".

E) With respect to claims 13 and 14:

Kita et al. describes a configuration in which extension data is looked for only with respect to programs of a specific genre [note paragraphs 0056 and 0069 of the translation document].



10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsh D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY  
Primary Examiner  
Art Unit 2621